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10/081,776	02/20/2002	James M. Barton	TIVO0003C-D	4827

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GLENN PATENT GROUP  
 3475 EDISON WAY  
 SUITE L  
 MENLO PARK, CA 94025

EXAMINER

TRAN, THAI Q

ART UNIT

PAPER NUMBER

2615

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/081,776

Applicant(s)

BARTON ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 43-53 have been renumbered 44-54.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

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published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 20-21, 23, 28,48-49, 51, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Logan et al (Re. 36,801).

Regarding claim 20, Logan et al discloses a process for a digital video recorder (Fig. 1), comprising the steps of:

storing a plurality of multimedia programs in digital form on a storage device (col. 3, lines 4-17);

playing back at least two of said multimedia programs from said storage device to at least one television monitor (col. 3, lines 4-17); and

wherein said playing back step allows playback rate and direction of each multimedia program to be controlled individually to perform variable rate fast forward and rewind, frame step, pause, and play functions (col. 3, line 63 to col. 4, line 5).

Regarding claim 21, Logan et al further discloses the claimed wherein said playing back step converts said at least two of said multimedia programs into television output signals (col. 3, lines 4-17).

Regarding claim 23, Logan et al discloses the claimed wherein a user controls the playback rate and direction of a multimedia program through a remote control (col. 3, lines 18-26).

Regarding claim 28, Logan et al discloses the claimed wherein an input signal tuner receives any of: software updates or data (col. 3, lines 4-17).

Apparatus claim 48 is rejected for the same reasons as discussed in method claim 20 above.

Apparatus claim 49 is rejected for the same reasons as discussed in method claim 21 above.

Apparatus claim 51 is rejected for the same reasons as discussed in method claim 23 above.

Apparatus claim 56 is rejected for the same reasons as discussed in method claim 28 above.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 22 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36, 801) in view of Mankovitz et al ('195 B1).

Regarding claim 22, Logan et al discloses all the features of the instant invention as discussed in claim 20 above except for providing inserting on-screen displays into a television output signal.

Mankovitz et al teaches that on-screen television guides can be used to select programs for viewing or recording (col. 1, lines 16-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known on-screen television guides as taught by Mankovitz et al into Logan et al's system in order to select programs for recording in unattended recording mode.

Apparatus claim 50 is rejected for the same reasons as discussed in method claim 22 above.

7. Claims 24-25 and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Fujita et al ('619 B1).

Regarding claim 24, Logan et al discloses all the features of the instant invention as discussed in claim 20 above except for providing a multimedia recording device, wherein said playing back step sends a multimedia program to said multimedia recording device, allowing a user to record said multimedia program.

Fujita et al teaches an image editing system having hard disk for storing the editing video signal (col. 2, lines 59-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the editing system as taught by Fujita et al into Logan et al's system in order to increase the quality of the video signal by editing the video signal.

Regarding claim 25, Fujita et al also discloses the step of providing editing means for creating custom sequences of video and/or audio output (col. 2, lines 59-65); and wherein said editing means allows any number of video and/or audio segments of multimedia programs to be lined up and combined and stored on said storage device (col. 2, lines 59-65 and Fig. 4).

Apparatus claims 52-53 are rejected for the same reasons as discussed in method claims 24-25.

8. Claims 26-27 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Kobayashi et al ('254).

Regarding claim 26, Logan et al discloses all the features of the instant invention as discussed in claim 20 above except for providing wherein said storing step separates a digitized analog multimedia program or digital multimedia program into its video and audio components before storing on said storage device.

Kobayashi et al teaches a digital video audio processing apparatus having means for separating the digital multimedia program into its video and audio components so that the video and audio signals can be processed separately from the serial digital video signal in which audio signal is mixed (col. 3, lines 49-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the switching system as taught by Kobayashi et al into Logan et

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al's system in order to increase the quality of the video signal by processing the video and audio signals separately.

Regarding claim 27, Kobayashi et al also discloses the claimed providing means for synchronizing video and audio components for proper playback (col. 3, line 66 to col. 4, line 7).

Apparatus claims 54-55 are rejected for the same reasons as discussed in method claims 26-27 above.

9. Claims 8-9, 13-15, 19, 36-37, 41-43, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Yasukohchi et al ('837 B1).

Regarding claim 8, Logan et al discloses all the features of the instant invention as discussed in claim 20 above except for providing a plurality of output devices.

Yasukohchi et al teaches a multichannel recording and reproducing apparatus having a plurality of output devices (102 of Fig. 1) for allowing plurality of users to access the video signal recorded on the disc unit (col. 5, lines 10-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of recording and reproducing multichannel video signal as taught by Yasukohchi et al into Logan et al's system in order to increase the flexibility of the system of Logan et al by allowing plurality of users to access video signal recorded on the disc unit.



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Regarding claim 9, Logan et al discloses the claimed wherein a user controls the playback rate and direction of a multimedia program through a remote control (col. 3, lines 18-26).

Regarding claim 13, Logan et al discloses the claimed wherein an input signal tuner receives any of: software updates or data (col. 3, lines 4-17).

Claim 14 is rejected for the same reasons as discussed in claim 8 above.

Claim 15 is rejected for the same reasons as discussed in claim 9 above.

Claim 19 is rejected for the same reasons as discussed in claim 13 above.

Apparatus claim 36 is rejected for the same reasons as discussed in method claim 8 above.

Apparatus claim 37 is rejected for the same reasons as discussed in method claim 9 above.

Apparatus claim 41 is rejected for the same reasons as discussed in method claim 13 above.

Apparatus claim 42 is rejected for the same reasons as discussed in method claim 8 above.

Apparatus claim 43 is rejected for the same reasons as discussed in method claim 9 above.

Apparatus claim 47 is rejected for the same reasons as discussed in method claim 8 above.

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10. Claims 10, 12, 16, 18, 38, 40, 44, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Yasukohchi et al ('837 B1) as applied to claims 8, 14, 36, and 42 above, and further in view of Fujita et al ('619 B1).

Regarding claim 10, the combination of Logan et al and Yasukohchi et al discloses all the features of the instant invention as discussed in claim 8 above except for providing a multimedia recording device, wherein said converting step sends any of a specific digital broadcast signal or a television output signal to said multimedia recording device for recording.

Fujita et al teaches an image editing system having hard disk for storing the editing video signal (col. 2, lines 59-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the editing system as taught by Fujita et al into Logan et al's system in order to increase the quality of the video signal by editing the video signal.

Regarding claim 12, Fujita et al also discloses the step of providing editing means for creating custom sequences of video and/or audio output (col. 2, lines 59-65); and wherein said editing means allows any number of video and/or audio segments of digital broadcast signals to be lined up and combined and stored on said storage device (col. 2, lines 59-65 and Fig. 4).

Claim 16 is rejected for the same reasons as discussed in claim 10 above.

Claim 18 is rejected for the same reasons as discussed in claim 12 above.

Apparatus claim 38 is rejected for the same reasons as discussed in method claim 10 above.

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Apparatus claim 40 is rejected for the same reasons as discussed in method claim 12 above.

Apparatus claim 44 is rejected for the same reasons as discussed in method claim 10 above.

Apparatus claim 46 is rejected for the same reasons as discussed in method claim 12 above.

11. Claims 11, 17, 39, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Yasukohchi et al ('837 B1) as applied to claims 8, 14, 36, and 42 above, and further in view of Mankovitz et al ('195 B1).

Regarding claim 11, the combination of Logan et al and Yasukohchi et al discloses all the features of the instant invention as discussed in claim 8 above except for providing inserting on-screen displays into a television output signal.

Mankovitz et al teaches that on-screen television guides can be used to select programs for viewing or recording (col. 1, lines 16-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known on-screen television guides as taught by Mankovitz et al into Logan et al's system in order to select programs for recording in unattended recording mode.

Claim 17 is rejected for the same reasons as discussed in claim 11 above.

Apparatus claim 39 is rejected for the same reasons as discussed in method claim 11.

Apparatus claim 45 is rejected for the same reasons as discussed in method claim 11.

12. Claims 1-2, 6-7, 29-30, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Kobayashi et al ('254) and further in view Yasukohchi et al ('837 B1).

Regarding claim 1, Logan et al discloses all the features of the claimed invention as discussed in claim 20 above except for providing separating a digital signal for digital television broadcast signal into its video and audio components and providing a plurality of output devices.

Kobayashi et al teaches a digital video audio processing apparatus having means for separating the digital multimedia program into its video and audio components so that the video and audio signals can be processed separately from the serial digital video signal in which audio signal is mixed (col. 3, lines 49-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the switching system as taught by Kobayashi et al into Logan et al's system in order to increase the quality of the video signal by processing the video and audio signals separately.

The combination of Logan et al and Yasukohchi et al does not specifically disclose providing a plurality of output devices.

Yasukohchi et al teaches a multichannel recording and reproducing apparatus having a plurality of output devices (102 of Fig. 1) for allowing plurality of users to access the video signal recorded on the disc unit (col. 5, lines 10-27).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of recording and reproducing multichannel video signal as taught by Yasukohchi et al into Logan et al's system in order to increase the flexibility of the system of Logan et al by allowing plurality of users to access video signal recorded on the disc unit.

Regarding claim 2, Logan et al discloses the claimed wherein a user controls the playback rate and direction of a multimedia program through a remote control (col. 3, lines 18-26).

Regarding claim 6, Kobayashi et al also discloses the claimed providing means for synchronizing video and audio components for proper playback (col. 3, line 66 to col. 4, line 7).

Regarding claim 7, Logan et al discloses the claimed wherein an input signal tuner receives any of: software updates or data (col. 3, lines 4-17).

Apparatus claims 29-30 and 34-35 are rejected for the same reasons as discussed in method claims 1-2 and 6-7 above.

13. Claims 3, 5, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Kobayashi et al ('254) and Yasukohchi et al ('837 B1) as applied to claims 1 and 29 above, and further in view of Fujita et al ('619 B1).

Regarding claim 3, the combination of Logan et al, Kobayashi et al, and Yasukohchi et al discloses all the features of the instant invention as discussed in claim 1 above except for providing a multimedia recording device, wherein said decoding step

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sends any of a specific video and audio component or a television output signal to said multimedia recording device for recording.

Fujita et al teaches an image editing system having hard disk for storing the editing video signal (col. 2, lines 59-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the editing system as taught by Fujita et al into Logan et al's system in order to increase the quality of the video signal by editing the video signal.

Regarding claim 5, Fujita et al also discloses the step of providing editing means for creating custom sequences of video and/or audio output (col. 2, lines 59-65); and wherein said editing means allows any number of video and/or audio segments to be lined up and combined and stored on said storage device (col. 2, lines 59-65 and Fig. 4).

Apparatus claim 31 is rejected for the same reasons as discussed in method claim 3 above.

Apparatus claim 33 is rejected for the same reasons as discussed in method claim 5 above.

14. Claims 4 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al (Re. 36,801) in view of Kobayashi et al ('254) and Yasukohchi et al ('837 B1) as applied to claims 1 and 29 above, and further in view of Mankovitz et al ('195 B1).

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Regarding claim 4, the combination of Logan et al, Kobayashi et al, and Yasukohchi et al discloses all the features of the instant invention as discussed in claim 1 above except for providing inserting on-screen displays into a television output signal.

Mankovitz et al teaches that on-screen television guides can be used to select programs for viewing or recording (col. 1, lines 16-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known on-screen television guides as taught by Mankovitz et al into Logan et al's system in order to select programs for recording in unattended recording mode.

Apparatus claim 32 is rejected for the same reasons as discussed in method claim 4 above.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to an apparatus for recording/reproducing video signal.

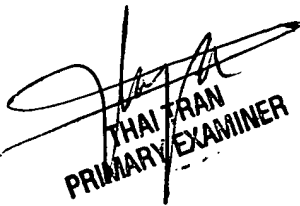
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TTQ  
October 21, 2002

  
THAI TRAN  
PRIMARY EXAMINER